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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,891

06/17/2005

Johnathan A Napier

13478-00001-US

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04/28/2009

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EXAMINER

ZHENG, LI

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

04/28/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,891	<b>Applicant(s)</b> NAPIER ET AL.	
	<b>Examiner</b> LI ZHENG	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-9, 26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-9, 26 and 27 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's amendments to claims 1-2 and submission of new claim 27 filed on January 14, 2009 has been entered.

As a result, claims 1-5 and 7-9 and 26-27 are pending and examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The rejections and objections that are not recited in this Office Action are considered as being withdrawn.

#### ***Claim Objections***

4. Claim 5 is objected to for being dependent on a rejected claim.

#### ***Claim Rejections - 35 USC § 112***

5. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office action mailed August 20, 2008. Applicants traverse in the paper filed January 14, 2009. Applicants' arguments have been fully considered but were not found persuasive.

Applicants argue that as disclosed in the specification and discussed in the amendment and reply filed 11/9/2007, delta-5-desaturases are well known in the art at the time of filing and that the specification provides 3 species of SEQ ID NO: 6, 8, 10 (response, the paragraph bridging pages 6-7).

The Office contends that the claim encompasses any delta-5-desaturase from any organism whereas the prior art and the specification only disclose a very limited number of delta-5-desaturases. They are not representative for any delta-5-desaturase from any organism.

5. Claims 1-5, 7-9 and 26 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for accumulate C16, C18 and C20 polyunsaturated fatty acids in transgenic plant expressing nucleotide sequences encoding SEQ ID NO: 2,4 and 6, does not reasonably provide enablement for any transgenic plant any delta-5-desaturase to produce any compound shown in formula I of claim 1 with a content of at least 1% by weight. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly

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connected, to practice the invention commensurate in scope with these claims, for the reasons of record stated in the Office action mailed August 20, 2008. Applicants traverse in the paper filed January 14, 2009. Applicants' arguments have been fully considered but were not found persuasive.

Applicants argue that compounds shown in Table 1 are representative of the compounds encompassed by the formula I of claim 1 with the (response, the paragraph bridging pages 7-8).

The Office contends that the working example in the specification only shows the data for the content of C16, C18 and C20 polyunsaturated fatty acids such as the ones listed in table 1, it does not provide any evidence that other compounds in the formula I of claim 1 are produced by the instant method. There is no evidence that the transgenically expressed enzymes would produce such unmanageable number of compounds as depicted in claim 1.

### ***Summary***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Zheng whose telephone number is 571-272-8031.

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The examiner can normally be reached on Monday through Friday 9:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on 571-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Elizabeth F. McElwain/  
Primary Examiner, Art Unit 1638